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THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
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EXAMINER

EDELMAN, BRADLEY E

| ART UNIT | PAPER NUMBER |
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2153

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary

Application No.

09/938,430

Applicant(s)

CHELINE ET AL.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5,16,17 and 25-27 is/are allowed.
- 6) ☒ Claim(s) 1,10-13 and 18-24 is/are rejected.
- 7) ☒ Claim(s) 2,6-9 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to Applicant's amendments and request for reconsideration filed on April 7, 2005. Claims 1, 2, 4-14, and 16-27 are presented for further examination.

Claim Objections

1. Claim 10 is objected to because of the following informalities: The claim appears to contain improper grammar in the preamble (i.e. the phrase "further comprising"). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears that the word "simultaneously" as used in the claims is misdescriptive. For instance, claim 18 states, "simultaneously transmitting said host name query to a plurality of DNS servers." While the specification describes sending the query from the modem to a plurality of DNS servers (see p. 27, line 29 – p. 28, line 8; see Fig. 5A, steps 514 and 516), it does not describe that it is in fact done simultaneously. Rather,

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the specification suggests that the requests are sent one after the other. Claims 19-21 depend from claim 18, and are thus rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahura (U.S. Patent Publication No. 2003/0009592), in view of Bhatia et al. (U.S. Patent No. 6,108,330, hereinafter "Bhatia").

In considering claim 1 Stahura discloses a computer implemented method for resolving host names on a network comprising:

Receiving a host name query from a client (¶ 2, "browser submits a resolution request that specifies the domain name to a local domain server");

Transmitting said host name query from the client to a plurality of DNS servers (¶ 2, "the local domain name server... forwards the resolution request to a root domain name server," and "the local domain name server then sends the resolution request to the top-level domain name server"); and

Returning a single address to said client computer (¶ 2, "IP address of the domain name [is returned] to the client computer"), where said single address is based

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on said host name query and any responses received from said DNS servers (it is the end result of the querying process, as described in ¶ 2).

However, Stahura does not disclose that the client sends its queries and receives responses via a modem. That is because Stahura does not discuss the hardware of the client in any depth. Nonetheless, it is well known that clients can connect to DNS query services using a modem, as evidenced by Bhatia (Fig. 1). Thus, given the teaching of Bhatia, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using a modem to connect the client taught by Stahura to the network, in order to allow users without direct connections to the Internet to use the system. Therefore, it would have been obvious to use a modem as taught by Bhatia, in the system taught by Stahura.

In considering claim 10, Stahura further discloses prior to transmitting said host name query, searching a cache for an address associated with said host name query, and if located, returning a located address to said client, such that the client computer can send a request for content to said address (¶ 2, "the local domain name server checks a local cache to determine whether it has a mapping of that domain name IP address").

In considering claim 11, the steps described in claim 11 essentially describe checking a client cache before making any host name query to a server, and returning content from the cache to the client computer if it has been stored in the cache (i.e. the

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language reads, "prior to transmitting said host name query, searching a cache based on said host name query, and if cached content associated with said host name query is located, returning said cached content to said client computer, such that said client can display said content"). Client-side caches are notoriously well-known in the art, and would have been obvious to include in the Stahura system to avoid extra network traffic.

4. Claims 13, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahura, in view of Poeluev (U.S. Patent Application No. 2003/0014541).

In considering claim 13, claim 13 describes a computer program product for performing the same steps as described in claim 1. However, instead of describing the use of a modem, claim 13 describes that the name resolution system resides on a Virtual Private Network (VPN). Although Stahura does not disclose the use of a VPN, systems that allow client computers to query DNS servers via a VPN are well known, as evidenced by Poeluev (§ 24). Given the teaching of Poeluev, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the Stahura system for VPN connections, to allow a user of the Stahura system to obtain access to public websites when connected to a VPN (see Poeluev, § 5). Therefore, it would have been obvious for the network taught by Stahura to be a VPN.

Claims 22-23 contain the same limitations as respective claims 10 and 11, and are thus rejected for the same reasons.

In considering claim 24, the combined system of Stahura and Poeluev inherently includes at least one of the plurality of DNS servers forming part of the VPN.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stahura, in view of Bhatia, and further in view of Poeluev.

In considering claim 12, although neither Stahura nor Bhatia disclose a VPN, systems that allow client computers to query DNS servers via a VPN are well known, as evidenced by Poeluev (§ 24). Given the teaching of Poeluev, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the Stahura system for VPN connections, to allow a user of the Stahura system to obtain access to public websites when connected to a VPN (see Poeluev, § 5). Therefore, it would have been obvious for the network taught by Stahura and Bhatia to be a VPN, as taught by Poeluev.

Allowable Subject Matter

6. Claims 4, 5, 16, 17, and 25-27 are allowed.
7. Claims 2, 6-9, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 18-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to disclose the additional features included in the claims listed above as compared to claim 1.

Notably, the features of claims 2, 4, 5, 14, 16, and 17, describing in the context of the claimed domain name resolution system a step of determining that a plurality of addresses were acquired from the DNS servers, and that all but one were eliminated according to specific criteria was not found in the prior art of record.

In addition, the features of claims 6, 18, and 25, describing in the context of the claimed domain name resolution system a step of determining whether a host has or has not been located by the DNS servers, and if so returning at least one address for the host, but if not performing a search using the host name query as a search string and returning a results address of where results of the search are located to the client computer was not found in the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BE
June 20, 2005

A handwritten signature in cursive script that reads "Bradley Edelman".